

as prior art. The Examiner's attention is respectfully directed to the enclosed translation of the French Application 99/00330 and the Verification of a Translation certificate attesting to the accuracy of the translation. The present application claims priority to the French Application 99/00330 filed on January 14, 1999. As the cited publications were both published after January 14, 1999, the cited publications cannot anticipate or render obvious the claimed invention.

In the outstanding Official Action, claims 1-9, 12-14 and 27-30 were rejected as allegedly being drawn to an improper Markush group. This rejection is respectfully traversed.

As the Examiner is aware, if the members of a Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without a serious burden, the Examiner must examine all the members of the Markush group in the claim on their merits.

Applicants respectfully submit that the Official Action fails to establish that an examination of all of the claims pending in the present application places a serious burden on the Examiner. Since the decisions in *In re Weber*, 580 F2d 455, 198 USPQ 328 (CCPA 1978) and *In re Hauss*, 580 F2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in the claim lacks unity of invention. *In re Harnish*, 631 F2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ 2d 1059 (BPAI 1984). As the Examiner is aware, §803.02 of the MPEP broadly states that unity of invention exists

where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

However, as noted above, the publications cited in the outstanding Official Action fail to qualify as prior art. It is respectfully submitted that the outstanding Official Action fails to provide a citation that shows that the Markush groups set forth in the claimed invention lack a common utility or a substantial structural feature disclosed as being essential to that utility.

Thus, although the outstanding Official Action advances the conclusory allegation that no common utility or structure is present in the claimed invention, no rationale or justification is given in support of this conclusion. Thus, it is respectfully submitted that the Markush rejection is improper and must be withdrawn.

In view of the present amendment response and the foregoing remarks, therefore, it is believed that this application is now in condition for allowance, with claims 1-39 as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

Respectfully submitted,

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By

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